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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,307	06/23/2000	Allen B. Childress	5053-27600	1776

7590 01/30/2007

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EXAMINER	
FRENEL, VANEL	
ART UNIT	PAPER NUMBER
3627	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/603,307	CHILDRESS ET AL.	
	Examiner	Art Unit	
	Vanel Frenel	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *60-63, 65, 68-75, 79-82, 84, 87-97, 99 and 102-108* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *60-63,65,68-75,79-82,84,87-97,99 and 102-108* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed on 4/25/06. Claim 60 has been amended. Claims 60-63, 65, 68-75, 79-82, 84, 87-97, 99 and 102-108 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 60-63, 65, 68-75, 79-82, 84, 87-97, 99 and 102-108 rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al (6,343,271) in view of Reed et al (5,862,325), for substantially the same reasons given in the previous Office Action and incorporated herein. Further reasons appear hereinbelow.

(A) Claim 60 has been amended to delete the word "and". However, this changes does not affect the scope and the breadth of the claim as originally presented/or in the manner in which was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

(B) Claims 61-63, 65, 68-75, 79-82, 84, 87-97, 99 and 102-108 have not been amended and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

Response to Arguments

4. Applicant's arguments filed on 4/25/06 with respect to claims 60-63, 65, 68-75, 79-82, 84, 87-97, 99 and 102-108 have been fully considered but they are not persuasive.

(A) At pages 12-17 of the 4/25/06 response, Applicant argues the followings:

(i) Peterson does not appear to teach or suggest "automatically determining a table of contents based at least in part on input received regarding the first insurance claim processing step and automatically displaying the table of contents included an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step and one or more additional insurance claim processing steps".

(ii) Reed does not appear to teach or suggest "automatically adding or deleting one or more steps from a table of contents in response to the received input from the first or second insurance claim processing step or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first or second insurance claim processing step".

(iii) Examiner's stated motivation to combine Peterson and Reed is insufficient.

(iv) Reed does not appear to teach or suggest insurance claim processing steps associated with table of contents properties, wherein determining the table of contents include determining insurance claim processing steps that are associated with the table of contents properties.

(v) Reed does not teach wherein the table of contents properties include a condition which specifies when an associated insurance claim processing step should be included in the table of contents.

(B) With respect to Applicant's second argument, Examiner respectfully submits that He relied upon the clear and unmistakable teaching of Peterson whom suggested:" Claims that have determined to be automatically adjudicable, based on criteria set by the insurer, are compared against an auto adjudication database which correspond to Applicant's claimed feature (See Peterson, Col.9, lines 17-33). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(C) With respect to Applicant's third argument, Examiner respectfully submits that He relied upon the clear and unmistakable teaching of Reed whom suggested:" In addition to the menu choices, a list of the appropriate class instances from the provider database 11 is displayed in order to select the data to edit, delete or preview which correspond to

Applicant's claimed feature (See Reed, Fig.9; Fig.22; Col.29, lines 33-41). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(D) With respect to Applicant's first argument, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977F. 2d 1443, 1445,24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir.1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See the previous Office Action). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a

holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App.& Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, In *re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

In addition, with specific reference to Applicant's remarks about the Peterson reference, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

(i) obviousness does not require absolute predictability;

(ii) non-preferred embodiments of prior art must also be considered; and

(iii) the question is not express teaching of references, but what they would suggest.

(E) With respect to Applicant's third argument, Examiner respectfully submits that He relied upon the clear and unmistakable teaching of Reed whom suggested:" In addition to the menu choices, a list of the appropriate class instances from the provider database 11 is displayed in order to select the data to edit, delete or preview which correspond to Applicant's claimed feature (See Reed, Fig.9; Fig.22; Col.29, lines 33-41). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

(F) With respect to Applicant's fifth argument, Examiner respectfully submits that He relied upon the clear and unmistakable teaching of Reed whom suggested:" In addition to the menu choices, a list of the appropriate class instances from the provider database 11 is displayed in order to select the data to edit, delete or preview which correspond to Applicant's claimed feature (See Reed, Fig.9; Fig.22; Col.29, lines 33-41). Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

V. F
V.F

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER